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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/041,835	10/25/2001	Jay S. Dweck	G08.007	4551

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EXAMINER

DENNISON, JERRY B

ART UNIT PAPER NUMBER

2143

DATE MAILED: 11/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/041,835

Applicant(s)

DWECK, JAY S.

Examiner

J. Bret Dennison

Art Unit

2143

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 24 August 2006.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4, 6-10, 12-16 and 18-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-4, 6-10, 12-16 and 18-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

RESPONSE TO AMENDMENT

1. This Action is in response to Application Number 10/041,835 received on 24 August 2006.
2. Claims 1-4, 6-10, 12-16, and 18-21 are presented for examination.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 8/24/2006 has been entered.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-4, 6-10, 12-16, and 18-21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admitted Prior Art (AAPA) in view of Davies et al. (U.S. 6,853,634).

3. Regarding claims 1, 9, 13, 15, 20, and 21, AAPA disclosed a network communication method, comprising:

identifying, for a communication session, an originator, a participant, and a classification group to which the participant belongs;

establishing, by said originator and based on said classification group, a reciprocity rule for said communication session; and

conducting said communication session involving said originator and said participant based on said reciprocity rule (AAPA, Spec, page 2, AAPA admitted IM services offered by America Online in which a session is started between a sender and intended recipients using reciprocal communication).

AAPA did not explicitly state wherein the originator established the reciprocity rule, governing an ability of said participant to send a message to said originator, wherein said reciprocity rule prevents said participant from sending a response in reply to a message from said originator.

In an analogous art, Davies disclosed alerting messages being sent to the user to inform him or her when members of the list of friends and associates sign on or off the ICQ system. Davies also disclosed that users are also able to control who contacts them (Davies, col. 2, lines 39-45).

Therefore, the system of Davies allows a first user to send messages to other users as well as allows the first user to set a rule that prevents other users from sending messages to the first user, making it impossible for the other users to reply to the first user's messages.

Both AAPA and Davies disclosed instant messaging services allowing users to establish a communication session.

Therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to incorporate Davies' teachings of establishing rules for communication into AAPA to provide users with more options for controlling their availability to other users while using the instant messaging service.

Claim 9 includes a communication device including limitations that are substantially similar to those of claim 1, and are therefore rejected under the same reasoning. Claim 13 further includes a communications port in order to communicate with a messaging server or a participant. It is inherent that the sending device of a sender using America Online includes a port to provide communication to the America Online Server as well as a participant and therefore claim 13 is also rejected under the same reasoning as claim 1. Claim 15 includes a messaging system including limitations that are substantially similar to those of claim 1, and are therefore rejected under the same reasoning.

4. Regarding claim 2, AAPA and Davies disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said identifying further comprises identifying a plurality of participants and wherein said conducting further comprises involving said plurality of participants (AAPA, Spec, page 2, AAPA admitted users of America Online having a chat rooms in which a sender may communication with a

plurality of recipients).

5. Regarding claim 3, AAPA and Davies disclosed the limitations, substantially as claimed, as described in claim 2, including establishing a plurality of reciprocity rules (AAPA, Spec, page 2, AAPA admitted the types of networks admitted require reciprocity in transmissions).

6. Regarding claims 4 and 14, AAPA and Davies disclosed the limitations, substantially as claimed, as described in claims 1 and 9, including wherein said identifying further comprises: selecting said participant from an address book (AAPA, Spec, page 2, AAPA admitted senders of America Online selecting from a Buddy List).

7. Regarding claim 6, 8, 10, 12, 16, and 18, AAPA and Davies disclosed the limitations, substantially as claimed, as described in claims 1, 9, and 15. The issues left out of AAPA are the reciprocity rule either preventing or permitting said participant from sending a response message to said originator and the ability to modify said reciprocity rule during said communication session. Examiner takes Official Notice (see MPEP § 2144.03) that "permitting or blocking recipients in responding to the originator as well as being able to modify the reciprocity rule during said communication" in an instant messaging environment was well known in the art at the time the invention was made.

8. It is suggested by Examiner that Applicant review the following related art:

Davies et al. (U.S. Patent Number 6,853,634) in which Davies disclosed that users of the ICQ instant messaging system are able to control who contacts them and to hide their presence on the internet when required (Davies, col. 2, lines 40-45). This clearly shows that the sender has the ability to permit or prevent recipients from responding as well as the sender being able to modify the rules during the communication when necessary.

9. Regarding claim 7, AAPA and Davies disclosed the limitations, substantially as claimed, as described in claim 1, including wherein said communication session is an Internet instant messenger session (AAPA, Spec, page 2, AAPA admitted America Online providing instant messenger services).

Response to Amendment

10. Applicant's arguments and amendments filed on 24 August 2006 with respect to claims 1-4, 6-10, 12-16, and 18-21 have been carefully considered but they are not deemed fully persuasive.

Applicant's arguments include:

"Davies does not disclose, reference, or even make a distinction between an originator and a participant, disclose or suggest any governing rule regarding 'responding' to a message from an originator, or any disclosure or suggestion of modifying a rule during a communication otherwise."

Examiner respectfully disagrees.

The claimed invention does not make any distinction between an originator and a participant other than the originator is a user that sends a message and the participant is a user that receives the message and is unable to respond.

As explained in the above rejection, Davies disclosed a system that allows a first user to send messages to other users as well as allows the first user to set a rule that prevents other users from sending messages to the first user, making it impossible for the other users to reply to the first user's messages. Therefore, the other users are unable to respond to any message that the first user sends.

Davies did not disclose any restriction as to when the user can control who contacts them. Therefore one of ordinary skill would consider users being able to control who can contact them at any instant during the communication session.

As it is Applicant's right to continue to claim as broadly as possible their invention, it is also the Examiner's right to continue to interpret the claim language as broadly as possible. It is the Examiner's position that the detailed functionality that allows for Applicant's invention to overcome the prior art used in the rejection, fails to differentiate in detail how these features are unique.

By the rejection above, the applicant must submit amendments to the claims in order to distinguish over the prior art use in the rejection that discloses different features of Applicant's claimed invention.

It is the Examiner's position that Applicant has not yet submitted claims drawn to limitations, which define the operation and apparatus of Applicant's disclosed invention in manner, which distinguishes over the prior art.

Failure for Applicant to significantly narrow definition/scope of the claims and supply arguments commensurate in scope with the claims implies the Applicant intends broad interpretation be given to the claims. The Examiner has interpreted the claims with scope parallel to the Applicant in the response and reiterates the need for the Applicant to more clearly and distinctly define the claimed invention.

Conclusion

Examiner's Note: Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

In the case of amending the claimed invention, Applicant is respectfully requested to indicate the portion(s) of the specification which dictate(s) the structure relied on for proper interpretation and also to verify and ascertain the metes and bounds of the claimed invention.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to J. Bret Dennison whose telephone number is (571) 272-3910. The examiner can normally be reached on M-F 8:30am-5pm.


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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A Wiley can be reached on (571) 272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



J. B. D.
Patent Examiner
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